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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,959	02/26/2002	Seah H. Lim	010.00131	5006
7590	02/28/2005		EXAMINER	
Kathy Smith Dias Esq Heslin Rothenberg Farley & Mesiti P C 5 Columbia Circle Albany, NY 12203-5160			UNGAR, SUSAN NMN	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/082,959	Applicant(s) LIM ET AL.
	Examiner Susan Ungar	Art Unit 1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on November 26, 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) 1-5 and 7-17 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 6 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/11/2003.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____.

1. The Election filed November 26, 2004 in response to the Office Action of September 20, 2004 is acknowledged and has been entered. Claims 1-17 are pending in the application and Claims 1-5 and 7-17 have been withdrawn from further consideration by the examiner under 37 CFR 1.142(b) as being drawn to non-elected inventions. Claim 6 is currently under prosecution.
2. Applicant's election of Group 4, claim 6, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP 818.03(a)).
3. Applicant adds claim 17, not previously submitted drawn to a method of making a cytotoxic T cell and argues that claim 17 is properly included with the claim of Group 4 as it relates to the method for generating the cytotoxic T cell of claim 6, thus search and examination of this groups does not impose a serious burden. The argument has been considered but has not been found persuasive and claim 17 has been properly withdrawn from consideration. Since applicant has elected Group 4, a cytotoxic T cell that specifically recognizes Sp-17, for action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, the embodiments of claims 17 directed to a method of producing said cytotoxic T cell has been withdrawn from consideration as being directed to a non-elected invention and only a cytotoxic T cell which specifically recognizes Sp-17 will be examined. See 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03. Newly submitted claim 17 is directed to an invention that is independent or distinct from the invention originally claimed because the inventions of claim 17 and Group 4, claim 6 are related as process of making and product made. The inventions are

distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the T cell product can be made by a process different than that claimed, that is, by transfecting dendritic antigen presenting cells with molecule encoding the antigen rather than by pulsing the dendritic cells with the antigen. Further, as drawn to the argument that the search of the two inventions would not be an undue burden on examiner, this argument has been considered but has not been found persuasive because the literature search, particularly relevant in this art, is not coextensive and different searches and issues are involved in the examination of each group. For these reasons the restriction requirement is deemed to be proper and is therefore made FINAL. It is noted however that should the elected product claim be found allowable process claims that are not commensurate in scope with an allowed product claim will be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are objected to as being indefinite in the use of designation. SP-17 as the sole means of identifying the antigen which the T cells specifically recognize. The use of laboratory designations only to identify a particular antigen renders the claims indefinite because different laboratories may use the same laboratory designations to define completely distinct antigens. Amendment of the claims to include, information which unambiguously defines the antigen is required

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 6 is rejected under 35 U.S.C. § 102(a) as being anticipated by Chiriva-Internati et al, Blood, 2000, 96:272b.

The claim is drawn to an isolated cytotoxic T cell which specifically recognizes Sp-17.

Chiriva-Internati et al specifically teach to an isolated cytotoxic T cell which specifically recognizes Sp-17 (see abstract). All of the limitations of the claims are met.

8. Claim 6 is rejected under 35 USC 102(b) as being anticipated by US Patent No. 4,665,032.

The claim is drawn to an isolated cytotoxic T cell which specifically recognizes Sp-17.

It is noted that the specification does not define the term "isolated", therefore for examination purposes, the term isolated is understood to mean T-cells isolated from the blood stream.

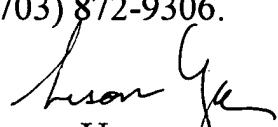
US Patent No. 4,665,032 specifically teaches PBMC isolated from human patients (see detailed Description of the Text, paragraph 9), a subset of which will be cytotoxic T-cells that bind to SP17.

9. No claims allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (571) 272-0837. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at 571-272-0787. The fax phone number for this Art Unit is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 872-9306.


Susan Ungar
Primary Patent Examiner
February 22, 2005